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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/091,704 10/13/98 FRANKE

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EXAMINER

SHEWAREGED, B

ART UNIT

PAPER NUMBER

1774

DATE MAILED:

07/19/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.  
09/091,704

Applicant(s)  
Franke

Examiner  
Betelhem Shewareged

Group Art Unit  
1774



☒ Responsive to communication(s) filed on Jun 2, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-64 is/are pending in the applicat

Of the above, claim(s) 2, 3, 16, 17, and 27-64 is/are withdrawn from consideration

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1, 4, 7-15, 18, 19, and 22-26 is/are rejected.

☒ Claim(s) 5, 6, 20, and 21 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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### DETAILED ACTION

1. Applicants response filed on 06/02/2000 has been fully considered. All rejections from the previous Office Action have been withdrawn in view of Applicant's amendment and comments.
2. Claims 1, 4-15 and 18-26 are amended, claims 1-64 are pending. Note: Applicant is advised to cancel non-elected claims 2, 3, 16, 17 and 27-64.

### *Claim Rejections - 35 USC § 112*

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 13 and 24<sup>new</sup> rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not disclose the transparent elastomer layer and the white-pigmented elastomer<sup>a</sup> layer are printed one on top of the other, but it discloses the

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transparent elastomer layer and the glue layer or the white-pigmented elastomer layer and the glue layer are printed one on top of the other.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 11, 12, 13, 22, 23 and 24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- a. In claims 11, 12, 22 and 23, the word 'type' extends the scope of the expression so as to render it indefinite. *Ex parte Copenhagen*, 109 USPQ 118 (Bd. App. 1955).

### ***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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8. Claims 1, 4, 7, 9, 13-15, 18 and 24-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Olsen (US 5,916,399).

Olsen discloses a transfer to be applied onto textiles, wherein the transfer comprises a base sheet made of paper having a heat softenable layer on at least one side of the base sheet, at least one color layer on the heat softenable layer, a transparent polyurethane elastomer extender layer on the color layer, and a hot-melt powder sprinkled over the extender layer. Since Olsen's extender layer is made of the same material as Applicant's transparent elastomer layer, Olsen's extender layer inherently has a high plasticizing layer. The heat softenable layer is made of silicone. The method used to make Olsen's transfer comprises steps of printing the at least one color layer over the base sheet, printing the transparent polyurethane elastomer layer over the at least one color layer, and sprinkling hot-melt powder over the extender layer while the extender layer is still wet. The extender layer is applied in a form of solution having polyurethane and organic solvent. The printing method used in this process is screen printing. (abstract; Fig. 2; col. 3, line 27 thru col. 4, line 21; col. 5, lines 19-22 and 44-46; and col. 6, lines 35-61). The claimed printing apparatus in claims 1, 14, 15 and 24 is not given patentable weight because these claims are directed to either article or process. In regard to claims 7 and 9, the methods used (i.e. forming a solution followed by applying the solution) are not given patentable weight because claims 7 and 9 are article claims and the limitations are directed to process steps. The limitations of the claims are met by the disclosure of the prior art.

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*Claim Rejections - 35 USC § 103*

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 1, 4, 7, 8, 9, 10, 13-15, 18, 19 and 24-26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Olsen (US 5,916,399).

Olsen discloses a transfer to be applied onto textiles, wherein the transfer comprises a base sheet made of paper having a heat softenable layer on at least one side of the base sheet, at least one color layer on the heat softenable layer, a transparent polyurethane elastomer extender layer on the color layer, and a hot-melt powder sprinkled over the extender layer. Since Olsen's extender layer is made of the same material as Applicant's transparent elastomer layer, Olsen's extender layer inherently has a high plasticizing layer. The heat softenable layer is made of silicone. The method used to make Olsen's transfer comprises steps of printing the at least one color layer over the base sheet, printing the transparent polyurethane elastomer layer over the at least one color layer, and sprinkling hot-melt powder over the extender layer while the extender layer is still wet. The extender layer is applied in a form of solution having polyurethane and organic solvent. The printing method used in this process is screen printing. (abstract; Fig. 2; col.

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3, line 27 thru col. 4, line 21; col. 5, lines 19-22 and 44-46; and col. 6, lines 35-61). The claimed printing apparatus in claims 1, 14, 15 and 24 is not given patentable weight because these claims are directed to either article or process. In regard to claims 7 and 9, the methods used (i.e. forming a solution followed by applying the solution) are not given patentable weight because claims 7 and 9 are article claims and the limitations are directed to process steps. Olsen does not disclose a white-pigmented extender layer.

At the time of the invention, it would have been obvious to a person of ordinary skill in the art to add a white pigment in the extender layer if a white extender layer is desired. Adding a dye, a pigment or a color changing agent into any material is a well known art and a conventional method.

#### *Allowable Subject Matter*

11. Claims 5, 6, 20 and 21 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

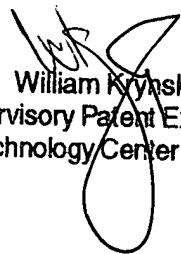
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*Conclusion*

12. Any inquiry regarding this communication or earlier communications from the Examiner should be directed to Betelhem Shewareged, whose telephone number is (703) 305-0389. The Examiner can normally be reached Monday to Thursday from 7:30 AM to 6:00 PM.

A facsimile center has been established in Group 1700, Crystal Plaza 3, 8th floor, reception area. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 305-3599 (for official after final faxes) or (703) 305-5408 (for all other official faxes). This location should be used in all instances when faxing any correspondence to Art Unit 1774. Use of the Group 1700 center will facilitate rapid delivery of materials to Examiners in Art Unit 1774.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0651.

  
William Krynski  
Supervisory Patent Examiner  
Technology Center 1700

BS *BS*

July 13, 2000.